

REMARKS

By this amendment, claims 18-33 have been cancelled. Thus, claims 11-17 are now active in the application. Reexamination and reconsideration of the application is respectfully requested.

In order to reduce the number of issues for consideration, and in an attempt to advance prosecution of this application, the present amendment is effective to cancel all claims except claims 11-17. In other words, the method claims 32 and 33, addressed by the Examiner in items 1-7 on pages 2 and 3 of the Office Action, have been canceled. In addition, in order to remove the issue described in the paragraph spanning pages 5 and 6 of July 23, 2004 Office Action, claims 18-31 have also been canceled.

Regarding the rejections of claims 11-17 as presented in items 1-3 on pages 3 and 4 of the Office Action, it is respectfully requested that the Examiner reconsider these rejections in light of the following remarks.

As recognized by the Examiner, present independent claim 11 (the only independent claim remaining) is directed to a pair of golf shoes including a right foot shoe and a left foot shoe, wherein an inflatable sealed bag 2 is provided only at the outside portion of the forward portion of the sole of only one of the right foot shoe and the left foot shoe, the inside portion of the forward portion of the sole of said one of the right foot shoe and the left foot shoe having no inflatable sealed bag thereat, and the other of the right foot shoe and the left foot shoe having no inflatable sealed bag.

In other words, considering the combination of the right foot shoe and the left foot shoe, there is provided an inflatable sealed bag at only the outside portion of the forward portion (i.e. the portion adapted to receive the little toe portion of the foot) of the sole of only one of the right foot shoe and the left foot shoe. No other portion of either shoe has an inflatable sealed bag provided at the sole. Also, the inflatable sealed bag has an air port 5 through which air can be injected to inflate the sealed bag. The sealed bag is thus arranged at the outside portion of the forward portion of the sole of said one of the right foot shoe and the left foot shoe so that, when a

corresponding one of the right foot and the left foot is received in said one of the right foot shoe and the left foot shoe and the sealed bag is inflated, the little toe portion of said one of the right foot and the left foot is raised relative to the big toe portion of said one of the right foot and the left foot.

As described in the present specification (in particular, please refer to paragraphs [0002] - 0010] on pages 1-3 of the substitute specification filed June 20, 2002), this particular arrangement of the present invention as recited in claim 11 is such that the sealed bag 2 can be inflated prior to the golfer taking a swing, so that the little toe portion 15L of one of the golfer's feet (in particular, of the left foot for a right-handed golfer, or the right for a left-handed golfer) is raised relative to the big toe portion of the foot. This little toe portion 15L (for a right-handed golfer) serves as a bracing portion during a downswing and, with the sealed bag inflated, allows for proper bracing even for a golfer, for example, a senior golfer, who has a somewhat weakened lower body. This bracing function allows for the golf swing to be correctly performed. Accordingly, it is important according to the present invention, and as specifically required by present independent claim 11, that an inflatable sealed bag is provided only at the outside portion of the forward portion of the sole of one of the right foot shoe and the left foot shoe of the pair of golf shoes.

The prior art rejection applied against claim 11 is a rejection under 35 U.S.C. 103(a) based on Miller, II (U.S. 6,550,160) in view of either O'Brien (U.S. 3,218,734), Wellman (U.S. 4,875,683), or Chiroff (U.S. 4,407,079). In the rejection, the Examiner stated:

*"Miller, II shows a pair of shoes with a sealed bag (22) located on the outside portion (lateral portion under the small toe) of the sole, a hand pump (48), and release valve (20) substantially as claimed except for the bag being located in the forward portion of the sole. **Miller, II is silent as to the longitudinal location of the bag.** O'Brien, Wellman, or Chiroff teaches that the location for medial/lateral augmenting devices for golfing should be located only in the forward portion of the shoe sole. It would have been obvious to locate the angling device only in the forward portion as taught by either O'Brien, Willman, or Chiroff in the pair of shoes*

of Miller, II to provide proper, secure angling of the foot for golfing." Emphasis added add (emphasis added).

In response to a similar statement in the previous Office Action (i.e. the November 22, 2003 Office Action), Applicant argued, in the response filed May 20, 2004, that, based upon the drawing figures of the Miller, II patent as well as the specification thereof, the bladder 22 of Miller, II is disclosed as extending longitudinally along the outside portion of the shoe, **including at the rear portion of the shoe**. More specifically, Applicant directed the Examiner's attention to Figs. 2-4 of the Miller, II patent and noted that each of Figs. 2-4 shows a longitudinal cross-section of the shoe of Fig. 1, and that it is apparent from an appraisal of the upper portion of each of these drawing Figures 2-4 that the cross-section is taken at a longitudinal portion of the shoe that includes the shoe opening through which the foot is inserted into the shoe (as clearly seen in Fig. 1). Since the shoe-opening portion of the shoe is provided at the rear portion of the shoe, not at the front portion of the shoe, it is apparent that the bladder 22, 42 shown in Figs. 2-4 of Miller, II is provided at least in the rear portion of the Miller shoe.

However, in response to these arguments presented by Applicant in the May 20, 2004 response, the Examiner stated (in item 4 on page 5 of the July 23, 2004 Office Action), the following

"In response to Applicants' arguments that the bladder of Miller, II is located in the heel, there is no clear basis for such an allegation. The cross sections relied upon by Applicant could also be cross sections in the forefoot portion anterior to the laces, i.e. towards the toe portion of the shoe or it could be a cross sectional view at a location in between eyelets. There is no clear basis in Miller, II as to the longitudinal location of the bladder in the specification or the drawings."

These assertions by the Examiner are respectfully traversed. It is respectfully requested that the Examiner reconsider the position taken in this regard, in consideration of the following comments.

First, and most importantly, the upper portion of each of Figs. 2-4 of Miller, II shows a downward "dip". The only longitudinal portion of the shoe illustrated in Fig. 1 of Miller, II which would include such a "dip" when viewed in longitudinal cross section would be the longitudinal portion of the shoe at the foot-insertion opening portion of the shoe at the rear portion of the shoe.

To better illustrate Applicant's point, annotated copies of Figs. 1 and 2 of Miller, II are presented below. In particular, the first-presented annotated figure is an annotated copy of Fig. 1 of Miller, II revised to show four section lines 2-2, A-A, B-B and C-C. The second through fourth-presented figures are modified versions of Fig. 2 of Miller, II to show schematic approximations of longitudinal cross-sectional views taken along lines A-A, B-B and C-C of the above annotated Fig. 1.

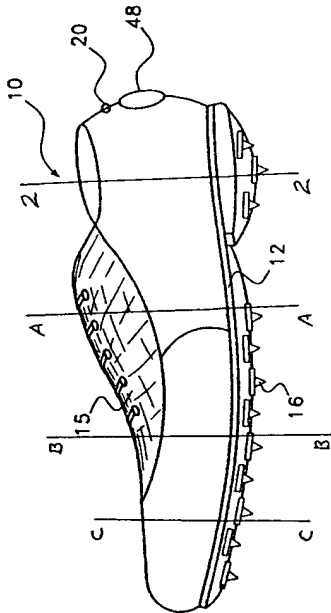


Fig. 1 (Annotated)

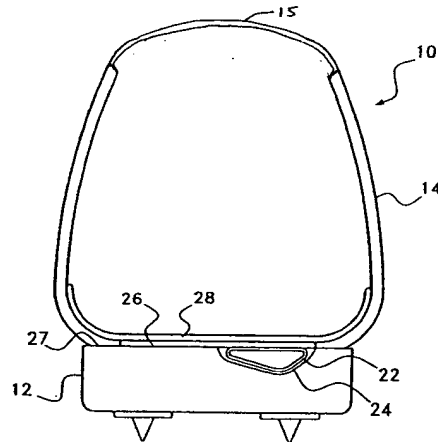


Fig. A-A

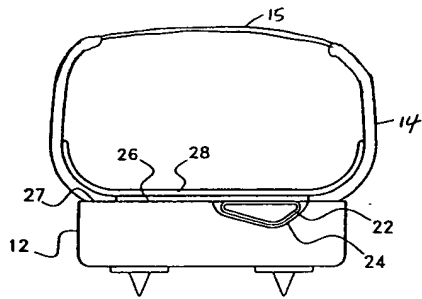


Fig. B-B

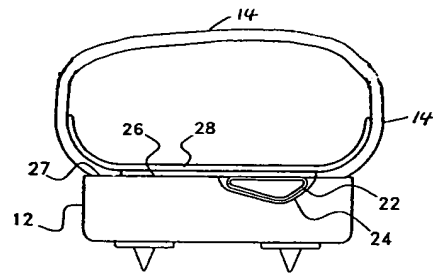


Fig. C-C

First, referring to the annotated Fig. 1 presented above, it is noted that reference numeral 14 identifies the upper section of the shoe which is disclosed as being of a "standard construction" made of "leather, canvas or another typical shoe material" (column 2, lines 51 and 52 of Miller, II). The reference numeral 15 identifies an area of the upper section of the shoe that can be made of an elastic material to allow the foot to move upwardly within the confines of the golf shoe without discomfort (column 2, lines 53-57 of column 2 of Miller, II).

Section line 2-2 of annotated Fig. 1 shows the location along which the cross-sectional view of Figs. 2-4 of Miller, II are taken, and section lines A-A, B-B and C-C of annotated Fig. 1 show the longitudinal locations along which the schematic approximations of the cross-sectional views A-A, B-B and C-C presented above are taken.

As will be noted and as should be understood, the view A-A taken along line A-A of annotated Fig. 1 must show an upwardly curved portion at the top of the figure to represent the upwardly protruding elastic area 15 of the shoe, in order to properly correspond to Fig. 1. Similarly, the Fig. B-B must show a slightly upwardly curved portion at the top part of the figure to represent the slightly upwardly protruding elastic area 15 of the shoe at the longitudinal location of the section line B-B of annotated Fig. 1 above, in order to properly correspond to Fig. 1. Fig. C-C is taken, not through the elastic area 15, but through the upper section 14. Still, the top of the Figure C-C must show a slightly upwardly curved portion to represent the top of the toe portion of the upper section 15 of the shoe at the location of the section line C-C of annotated Fig. 1, in order to properly correspond to Fig. 1.

In addition to the presence at the top of each of Figs. A-A, B-B and C-C of an upwardly curved portion, the following should be considered when reviewing the Miller, II drawing figures.

Contrary to the Examiner's assertion that "[t]he cross sections relied upon by Applicant could also be cross sections in the forefoot portion anterior to the laces, i.e. toward the toe portion of the shoe", the height of the cross sections of Figs. 2-4 of Miller, II is clearly a height at the rear of the shoe and not near the toe portion of the shoe.

Contrary to the Examiner's assertion that "it could be a cross sectional view at a location in between eyelets," it is noted that Figs. 2-4 show the sole 12 in Figs. 2-4 as having a large thickness, whereas such large thickness of the sole 12 is not shown in Fig. 1 at the area beneath the laces portion of the shoe. Rather, the large-thickness portion of the sole 12 is shown only at the heel portion of the shoe in Fig. 1 of Miller, II.

Next, it is noted that, in the response filed May 20, 2004, Applicant argued further that the description of Miller also makes it apparent that the bladder 22, 42 of Miller, II must be provided at least at the rear portion of the Miller, II shoe in view of the description that "one side of the foot is elevated to a height above the opposite side of the foot within the shoe" (see column 2, lines 11-14). Also see column 2, lines 14-17, "[b]y slanting the shoe from right to left, a right

handed person is reminded to keep his/her weight on the left side of their foot when swinging a golf club, thereby making for a better swing." Also see column 3, lines 6-8, "[t]he bladder tilts the foot so that a right-handed person is forced to place their weight on the inside portion of their right foot." In order to obtain these functional result described in the Miller specification, it would be necessary to have bladder 22, 42 provided at least at the rear portion of the shoe; providing the bladder at only the forward portion of the shoe would not cause "one side of the foot [to be] elevated to a height above the opposite side of the foot within the shoe" as described in Miller, II (column 2, lines 11-14).

As such, a modification of the Miller, II shoe to include the bladder 22, 42 at only the outside portion of the forward portion of the sole of one of the shoes, would significantly alter the function and intended object of the Miller, II golf shoes, and accordingly, it is respectfully submitted that a person having ordinary skilled in the art would clearly not have been motivated to modify Miller, II in view of any of O'Brien, Wellman or Chiroff, or otherwise, in such a manner as to result in or otherwise render obvious the present invention of present claim 11.

The Examiner cited the Goldston and Cohen patents for teaching "placing hand pumps and valves on tongues of footwear." However, these references provide no teaching or suggestion that would have obviated the above-discussed shortcomings of the Miller, II patent or that would have otherwise motivated a person of ordinary skill in the art to modify Miller, II in such a manner as to result in or otherwise render obvious the present invention of claim 11.

Thus, it is submitted to be apparent from the above discussion and the above annotated drawing sketches that the Miller, II patent shows, in Figs. 2-4, only that the bladder 22, 42 is present at least at the rear portion of the shoe below the foot-insertion opening thereof.

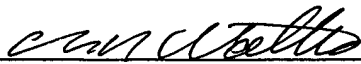
For these reasons, it is respectfully requested that the Examiner reconsider and withdraw the prior art rejections presented against claims 11-17 in the July 23, 2004 Office Action.

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is clearly in condition for allowance. An early notice thereof is earnestly solicited.

If, after reviewing this Amendment, the Examiner feels there are any issues remaining which must be resolved before the application can be passed to issue, it is respectfully requested that the Examiner contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

Nariie KANEKO

By: 
Charles R. Watts
Registration No. 33,142
Attorney for Applicant

CRW/asd
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
October 21, 2004